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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,100	06/25/2003	James M. Odom	2233.001	4189
27834	7590	02/27/2006	EXAMINER	
LAW OFFICE OF RAY B. REGAN			SPRIGG, SEAN M	
P.O. BOX 1442			ART UNIT	
CORRALES, NM 87048			PAPER NUMBER	

3713

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

Office Action Summary	Application No.	Applicant(s)	
	10/606,100	ODOM ET AL.	
	Examiner	Art Unit	
	Sean Sprigg	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/25/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims place a limitation of a "step of assembling" when there are multiple steps of assembling which claims 3 and 5 could be further limiting. Claim 1, of which both claims 3 and 5 are dependent on, contains two steps of assembling, one that assembles pre-qualifying data and the other that assembles concluding data. Meanwhile claims 2 and 4, the parent claims of claims 3 and 5 respectively, add the limitations of an "assembling preliminary ranking data" and "assembling concluding ranking data" respectively. Therefore, it is unclear as to which "step of assembling" claims 3 and 5 is further limiting. For the purposes of this examination, claims 3 and 5 will be interpreted to be further limiting the steps of "assembling pre-qualifying data" and "assembling concluding data" respectively.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13, 15-16, and 18-21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claimed invention as a whole must have a “useful, concrete and tangible” result to have a practical application.” Please see MPEP 2106 Section II A. As the claims are currently written, no tangible result is achieved, as the method could be performed mentally resulting in no tangible result. For example, an individual assembling data via communications with a distributor, manipulating the data mentally, and determining winning conditions based on the data could perform the steps of the claims listed above without causing anything to tangibly change in the real world. In contrast, claims 14 and 17 provide a tangible result in the form of a prize being awarded, and claims 22-27 describe tangible systems. Therefore, the invention as claimed in steps 1-13, 15-16, and 18-21 lack patentable utility by lacking a “useful, concrete and tangible” result.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-14 and 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hannan'627 (US Pub. No. 2004/0029627).

Hannan'627 teaches a method of lottery wagering on a phased competition (see par. 11) having the steps of assembling pre-qualifying data such as ranking data of participants of a pre-qualifying event (see pars. 11-12, 52), assembling concluding data such as rankings for participants of a final event (see par. 51), determining at least one winner of the final event based on the concluding data (see par. 51), correlating the concluding data of a winner of the event with the pre-qualifying data of the winner (see pars. 51-52), and determining the winning lottery data based on the correlating step (see pars. 51-52). With regard to the pre-qualifying data, the preliminary participants, and the pre-qualifying event, Hannan'627 teaches that the winning criteria are established by the outcome of "an actual scheduled sporting event or series of events" like a golf tournament or auto race (see pars. 11 and 14). The pre-qualifying data as described in Hannan'627 are the rankings of participants entering the current event, wherein the participants of the event could be a subset of a larger group that contains participants that did not qualify for the current event due to a low ranking. For instance, in entering a tournament such as a tennis, golf, basketball, or football tournament, certain teams or individuals will have rankings from regular season play or a qualifying event, which aids in the seeding of the teams or individuals and helps determine which individuals will be allowed to enter the tournament. Therefore, Hannan'627 teaches a phased competition with a pre-qualifying event, preliminary participants, pre-qualifying data, concluding data, final participants, and a final event. Hannan'627 also teaches the collecting and correlating of data with regards to participants (see pars. 11-12 and 51-52). Hannan'627 also teaches a player of the lottery wagering method providing

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wagering data selecting, either randomly or manually, the participants they believe will finish in a certain subset of winning participants of the final event (see pars. 47, 50, 57, and 75). The player makes the wagering selections with a lottery distributor over a communication link of a computer network, the Internet, landline telephony, or other forms of communication (see pars. 39-42, 75 and 76). Hannan'627 teaches that the wagering data submitted by the player is compared to the winning lottery data and that the player is awarded a prize for making all or some of the correct selections in the lottery (see pars. 11-13 and 51-52). Hannan'627 teaches that the player can change the wagering selections before the conclusion of the final event (see par. 48).

Hannan'627 also teaches the method being applied to the sport of auto racing, wherein the "pole" position or ranking would be used as a pre-qualifying event's wagering numbers, and the determination of the lottery numbers would be the "pole" position of the winning participants (see par. 14). Hannan'627 finally teaches a system with a distributor with a storage medium, a means for correlating data, a communication link to the player of the lottery game (including through a computer network or the Internet), a hub (or server) for sharing information between distributors, and a communication link to the hub for receiving game information (see pars. 39-42, 75 and 76).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hannan'627. Hannan'627 teaches all the features of the present invention, but does not explicitly teach the entering of a players wager into a second lottery phase based upon the outcome of the comparing step, or the shuffling of pre-qualifying data. Hannan'627 does teach that the lottery method could be applied to a tournament such as a golf tournament, tennis tournament, or a bass fishing tournament (see par. 11). It is well known that tournaments can have phased competition in which winners continue to the next round of play while losers are excluded. Therefore, Hannan'627 teaches that the player's wager could apply and be entered into multiple phases of a tournament based upon the outcome of the first phase lacking a tournament winner. Alternatively, a player could simply place the same wager in a second phase of a tournament based on the outcome of the first phase of the tournament. It would have been obvious at the time the invention was made to perform these functions to allow more opportunities for players to place wagers and increase the distributors income. Hannan'627 also teaches that a prize could be awarded and that the wagering data could be randomly selected as described above for the first phase.

Regarding the shuffling of pre-qualifying data, Hannan'627 teaches that the wager could be randomly selected which is in effect placing no weight on the actual ranking and allowing the processor to shuffle the rankings, picking a number of participants with random ranking values. Alternatively, the player could make their selections purely based on the players they believe will win the event and not on any displayed rankings, effectively shuffling the pre-qualifying data. In yet another

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alternative, Hannan'627 teaches that players can be grouped to change the size of the total number of pre-qualifying participants, which effectively changes the rankings of certain participants to not properly reflect their actual pre-qualifying data. Furthermore, it would have been obvious at the time the invention was made to provide the selection options in a shuffled format so as to encourage selection based on participants' history of performance by recognizing names, adding a skill element as taught in Hannan'627 par. 21, rather than on just rankings of participants entering the event.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnston'239 (USPN 5,518,239), Casa'679 (USPN 5,613,679), Maksymec'270 (USPN 6,527,270), Krynicky'656 (US Pub. No. 2004/0048656), and Downes'965 (USPN 6,910,965).

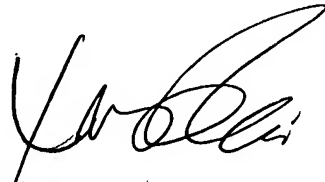
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Sprigg whose telephone number is (571) 272-5562. The examiner can normally be reached on Monday - Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMS
2/17/2006



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TC3700